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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,529	12/11/2003	Kevin S. Marchitto	156874-0079	9713

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IRELL & MANELLA LLP  
1800 AVENUE OF THE STARS  
SUITE 900  
LOS ANGELES, CA 90067

EXAMINER
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PEFFLEY, MICHAEL F

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 02/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/734,529

Applicant(s)

MARCHITTO ET AL.

Examiner

Michael Peffley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 73-91 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 73-91 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/11/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

The instant filed application is a continuation of US Serial Number 10/083,088. The preliminary amendments filed with the filing of the instant case are identical to the amendments filed in the parent application. Therefore, the issues in the instant application are identical to those of the parent case. The instant Office action is a substantial duplicate of the Final Office action mailed June 11, 2003 in the parent application.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Specification***

The amendment filed December 11, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: a removable applicator body. The original specification shows an applicator body (30) with a distal end (32). However, the distal end is disclosed to be a thermoelectric element and there is no specific mentioning that the applicator body is removable from the housing.

Applicant is required to cancel the new matter in the reply to this Office Action.

Additionally, applicant is respectfully requested to update the first sentence of the specification to provide the most current status (e.g. US Patent Number or "now abandoned") for each of the related applications.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 75, 79 and 81-91 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as originally filed did not disclose an applicator body which was removably mounted to the laser device housing.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 73, 75-77, 79-81, 83, 84, 86-88, 90 and 91 are rejected under 35 U.S.C. 102(b) as being anticipated by Muller et al ('426).

Muller et al disclose an applicator (12) which includes a body and a distal end with an opening. The applicator body is movably mounted within a laser device housing (2a) such that when a minimum amount of pressure is applied to the distal end by contact with tissue, the distal end moves into a position substantially in a focal plane of the laser device (1'). The examiner maintains that the applicator is inherently removable from the housing, and the distal end of the applicator is located at a distance

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from the housing greater than the distance from the housing to the focal plane when less than the minimum amount of pressure is applied thereto. The steps of making/attaching such an applicator is inherent to the structure as disclosed.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 74, 78, 82, 85 and 89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muller et al ('426) in view of the teaching of Davis ('319).

Muller et al disclose a laser applicator as discussed previously. Muller et al fail to teach of providing an ink or pigment on the applicator for marking the tissue.

Davis discloses a light applicator element (2) having a distal end (4) for contacting tissue. In particular, Davis teaches that ink may be used mark the tissue (col. 3, lines 55-60).

To have provided the Muller et al applicator with ink for marking tissue prior to treatment would have been an obvious modification for one of ordinary skill in the art in view of the teaching of Davis.

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11

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F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 73, 75-81, 83, 84, 86 and 88 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-50 of U.S. Patent No. 5,643,252. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claiming of the entire system (i.e. lasing element, power source, etc) is deemed to be an obvious combination of elements, particularly since the movable applicator is claimed in the '252 patent (e.g. claims 10+).

### ***Response to Amendment***

The preliminary amendment filed on December 11, 2003 is identical to the amendment originally filed on February 26, 2002 in the parent application. The examiner maintains the position asserted in the Final Office Action of June 11, 2003, the arguments supporting this position repeated below.

Concerning the 35 USC 112, first paragraph rejections, the examiner disagrees with applicant's assertion that the original disclosure inherently discloses the removable feature of the applicator body. There is nothing in the figures which suggests that the applicator may be removable, nor is there any description of the connection between

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the applicator and the body to suggest that the elements are formed in such a way as to make them removable. Further, the examiner asserts that the standard for review of the claims under 35 USC 112 with regard to the clarity of the claims and enablement of the disclosure is separate from the standard of review of the claim language under 35 USC 102 with respect to prior art. While the examiner maintains that the Muller et al applicator body is "removable" in the broadest reasonable sense of the term (e.g. the applicator may be broken from device) and the cited art therefore meets the limitation, this does not mean that applicant's specification inherently describes the claimed invention in sufficient detail. Clearly, applicant is not attempting to describe/claim a device whereby the applicator body may be destroyed in order to remove it from the laser housing. Applicant's disclosure fails to specify the type of connection between the applicator and the laser housing, and applicant may not rely on what one of ordinary skill in the art could deduce in order to complete the disclosure. The examiner does agree that the figures do clearly show a hole located in the applicator.

With regard to the 35 USC 102 rejection, the examiner contends that whether or not an optical fiber has a focal plane is immaterial to the claim language. Claim 73 recites an applicator "for use with a laser device". Hence, it is the applicator and not the laser device which is being claimed. Further, claim 73 recites an applicator distal end which is "positionable substantially in a focal plane of the laser device". This language implies a function, but still does not positively recite a laser device or any other feature which physically requires a "focal plane". The examiner maintains that while the Muller et al optical fiber may not have a focal plane, there are certainly optical fibers which

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have focal planes (e.g. Goldenberg '912) and the movable nature of the applicator provides the structure necessary to anticipate the functional nature of the claim language. The remaining claims, including method claim 84, recite similar functional language which does not positively include a device with a focal plane. As such, the examiner asserts the rejection of the claims is tenable and is maintained.

Applicant has not substantively argued the 35 USC 103 rejections except to the extent that applicant believes the 35 USC 102 rejections to be invalid. Again, the examiner maintains the 35 USC 102 rejection of the claims to be tenable and the 35 USC 103 rejections are also maintained for the reasons asserted in the previous Office action.

Finally, applicant asserts that the '252 patent fails to address an applicator which is positionable substantially in a focal plane of the laser device. The examiner disagrees. Claim 12 specifically sets forth that the movement of the applicator results in a focal point of the beam located within about 5mm (i.e. "substantially in a focal plane") of the applicator. The obvious type double patenting rejection is therefore maintained.

### ***Conclusion***

This is a continuation of applicant's earlier Application No. 10/083,088. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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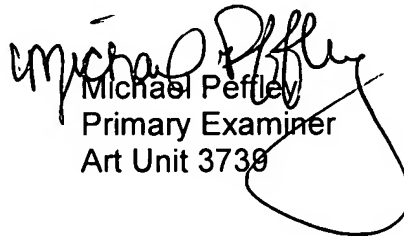
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (571) 272-4770. The examiner can normally be reached on Mon-Fri from 6am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Michael Perley  
Primary Examiner  
Art Unit 3739

mp  
February 15, 2006